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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,117	03/09/2000	William Scott Caldwell	627-311CT	2879

7590

07/29/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/522,117	CALDWELL ET AL.	
	Examiner	Art Unit	
	Venkataraman Balasubramanian	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicants' response, which included amendment to claims 22, 25-27 and addition of new claims 28-29, filed on 5/8/2003, is made of record.

Claims 22-29 are now pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/8/2003 has been entered.

In view of applicants' response the following apply.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23, 25-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell et al. US 5,861,423 for reasons of record. Note this rejection, which is same as made in the previous office action, includes the newly added claim 29 and excludes claim 24, and newly added claim 28.

Applicants' argument to overcome this rejection with a declaration from Dr. Caldwell is not persuasive.

First of all applicants' should note that paper # 22 and Dr. Caldwell declaration along with various exhibits attached to the declaration are missing from the application. It appears to have been misplaced during an in-process review and examiner had made efforts to get these papers but have not succeeded so far. Examiner will continue to seek these papers from the Reviewer. However, it would be helpful, if applicants could kindly provide these papers to further examination and allow this application.

The response to applicants' traversal is therefore based on previous rebuttal.

The Declaration by Dr. Caldwell is insufficient to overcome the above rejections because the results provided are not commensurate in scope with the claims. The instant claims are drawn to compounds having a  $\alpha$ -methyl substituent on the carbon atom of the side chain to which N-methyl nitrogen is attached. Both cis and trans as well as R and S isomers are embraced. However, all of the data provided in Table 5 and the discussion of unexpected superiority is with respect to compounds having a  $\alpha$ -methyl substituent on the carbon atom, which is next to the amino group especially the trans, R and S compounds. Even among the compounds having  $\alpha$ -methyl, the superiority is established in favor of S-isomers, see the discussion in paragraph 11 on page 5. Particularly, from the results provided in Table 5, no superiority is observed for the R-isomer (compound 2) as compared to the unsubstituted compound (compound 1) in terms of the activity ratio. It is also true when comparing the activity ratio data provided in Table 5, no significant difference has been observed between the  $\alpha$ -methyl

R-isomer (compound 2) compared to the unsubstituted compound (compound 1) both of which appear to be better than compound 3. Further, applicant's conclusion is also with respect to the superiority of  $\alpha$ -methyl compounds and particularly towards the S enantiomers (see paragraph 11 in page 5), therefore, the comparative data is not found to be commensurate in scope with the claims. There is no theory provided detailing how to extrapolate the data of the  $\alpha$ -methyl S-isomers to other compounds encompassed by the claimed genus, i.e., compounds wherein the  $\alpha$ -methyl group R and S with both cis and trans geometrical thereof. Such comparative data and/or explanation would be necessary to establish that the provided evidence is of probative value. See MPEP 716.02(d).

In summary, applicants are urging unexpected/superior properties for R isomer and cis R, S-isomers but there is no direct evidence provided to show that such changes would alter the metabolic profile asserted as unexpected/ superior over the prior art compound which also has cis and trans isomers. Such an extrapolation of data based on S-trans isomer is deemed as not a proper showing.

See Ex parte Gelles 22 USPQ 2nd 1318. Note Gelles, especially the following quote: " The evidence relied upon also should be reasonably commensurate in scope with the subject matter claimed and illustrate the claimed subject matter " as a class" relative to prior art subject matter."

See also MPEP 716.02(e), which states:

Showing unexpected results over one of two equally close prior art references will not rebut prima facie obviousness unless the teachings of the prior art references

are sufficiently similar to each other that the testing of one showing unexpected results would provide the same information as to the other. *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984).

For all the above reasons, the rejections under 35 USC 103(a) are maintained.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending

Application No. 08/631,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter embraced herein is also embraced in the copending application 08/631,761.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 21-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No.09/642,351 Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter embraced herein is also embraced in the copending application 09/642,351

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Note all these rejections were same as made in the previous office action and are maintained.

**PTO has not processed applicants' terminal disclaimer yet. Once processed, the above double patenting rejection over 08/631,761 and 09/642,351 would be obviated.**

### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from

Art Unit: 1624

8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

*V. Balasubramanian*  
Venkataraman Balasubramanian

7/25/2003